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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,447	08/18/2003	Bayard S. Webb	112300-1609	7040

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BELL, BOYD & LLOYD LLP
P.O. Box 1135
CHICAGO, IL 60690

EXAMINER	
KARKHANIS, AASHISH	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/644,447	WEBB ET AL.	
	Examiner	Art Unit	
	Aashish Karkhanis	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/18/03,4/27/06,4/27/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1 – 49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 36 of U.S. Patent No. 6,632,141. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose substantially identical subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 – 4, 6 – 35, 38, 41, 44 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Pierce et al. (U.S. Patent 6,139,013).

Regarding Claims 1, 8, 12, 14 – 16, 18 – 19, 22, 25, 27 – 28, 32, 35, 38, 41, 44 and 47, Pierce discloses a gaming device including a display device and a processor operable with said display device (col. 13, lins. 1 – 9) comprising: a primary game operable upon a wager by a player, a plurality of player selectable selections, a plurality of offers associated with a plurality of said selections (col. 3, lins. 27 – 32; where reel or slot games include basic terminator game symbols, anti-terminator symbols which may begin bonus games, and pay tables for wagering and prize awards), a plurality of terminators associated with one of said selections, at least one anti-terminator associated with one of said selections (col. 3, lins. 50 – 55; where primary and bonus games are played, and bonus games are triggered by bonus game anti-terminator symbols in a basic game), and a triggering event in said primary wagering game, wherein after the occurrence of said trigging event the player is enabled to pick one of the selections (col. 3, lns. 50 – 55; where a bonus game is played after a player randomly selects an anti-=terminator bonus symbol), said anti-terminator is retained if said anti-terminator is associated with the player picked selection, a terminating event occurs if said terminator is associated with the player picked selection and said anti-terminator is not retained, the player is enabled to accept the offer associated with the player picked selection if one of said offers is associated with the player picked selection (col. 3, lins. 43 – 55; where a game ends and a new game begins if no bonus

conditions are met and a bonus game is played if bonus conditions are met, where conditions include anti-terminator bonus game symbols), said accepted offer is provided to the player if the player accepts the offer associated with the player picked selection and the player is enabled to pick at least one subsequent selection if the player does not accept the offer associated with the player picked selection (col. 9, lins. 50 – 63; where a player is presented the option to attempt to double the award or keep the present award), wherein if said terminator is associated with the subsequently picked selection, said retained anti-terminator nullifies said terminator associated with the subsequently picked selection (col. 2, lins. 24 – 28; where a bonus game does not require all symbols on a payline to be bonus anti-terminator symbols, and one is sufficient to activate a bonus game).

Regarding Claims 2, 9 and 26, Pierce discloses a gaming device wherein a plurality of terminators are associated with the selections, wherein each terminator is associated with one of said selections, wherein a plurality of anti-terminators are associated with the selections, wherein each anti-terminator is associated with one of said selections (col. 3, lins. 27 – 32; where reel or slot games include basic terminator game symbols, anti-terminator symbols which may begin bonus games, and pay tables for wagering and prize awards, and which are randomly selected to create a winning, losing, or bonus sequence), wherein a number of terminators associated with said selections is greater than a number of anti-terminators associated with said selections (col. 3, lns. 27 – 32, where it is more likely to hit a basic than bonus symbols).

Regarding Claims 6, 10 – 11 and 34, Pierce discloses a gaming device wherein if one of the selections associated with a terminator is picked and at least one anti-terminator is not retained, the player is provided an award which is selected from the group consisting of: a previous offer, a consolation award and an award associated with a subsequent selection wherein a recommendation that the player accepts a previous offer is displayed prior to revealing the offer associated with at least one of the player picked selections. (col. 3, lins. 27 – 32; where a conventional reel or slot game has awards based on combinations of basic game terminator symbols as is well known and established in the art).

Regarding Claim 7, Pierce a gaming device wherein if any anti-terminator is retained when the player accepts an offer, a modifier associated with said anti-terminator is applied to the accepted offer (col. 3, lins. 27 – 32; where a bonus award is added to the base award of a reel game as is well known and established in the art of reel game bonuses).

Regarding Claim 13, Pierce discloses a gaming device of claim 12, wherein the plurality of player picks is increased by at least one if the player picks a selection having an anti-terminator associated with said selection (col. 3, lins. 38 – 43; where a bonus game is an additional pick available to a player when anti-terminator bonus symbols are present in a basic game).

Regarding Claim 17, Pierce discloses a gaming device which includes an award modifier associated with said anti-terminator, wherein the processor applies the award modifier to an offer accepted by the player if the player accepts an award when the

processor has an accumulated anti-terminator (col. 9, lins. 50 – 63; where a player is presented the option to attempt to double the award or keep the present award).

Regarding Claim 20 and 23, Pierce discloses a gaming device which includes a number of player picks of said selections, wherein the processor reduces the number of picks of said selections by one each time the player picks one of said selections (col. 3, lins. 30 – 35; where any specific method of modifying a base reel or slot game that does not specifically affect the play of a bonus game may be used, including reducing or increasing the number of picks allowed in a base game).

Regarding Claims 21 and 24, Pierce discloses a gaming device wherein the processor enables the player to accept or reject the offer associated with the player picked selection if the number of player picks is at least one (col. 9, lins. 50 – 63; where a player is presented the option to attempt to double the award or keep the present award, and is only presented this option if a primary game has already been played, where a primary game is a first pick, a bonus game is a second pick, and a double or nothing game is a third pick).

Regarding Claim 29, Pierce discloses a gaming device wherein the processor provides the player with a consolation award if a terminator is associated with the selection picked by the player and the processor does not have a retained anti-terminator (col. 3, lins. 27 – 32; where a basic reel game may provide awards for winning reel combinations as is well known and established in the art even if no bonus game is activated).

Regarding Claims 30 – 31, Pierce discloses a gaming device wherein the processor randomly selects said offers associated with the selections from a plurality of pools of offers (col. 7, lins. 15 – 30; col. 12, lins. 27 – 42; payout tables I and IV are exemplary of reel game pay tables and bonus game pay tables).

Regarding Claim 33, Pierce discloses a gaming device wherein the number of offers is equal to the number of selections (col. 3, lins. 27 – 32; where a single game is a single selection with a single award offer).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce.

Regarding Claim 5, Pierce discloses a gaming device wherein a previous offer is displayed and is associated with at least one of the player picked selections (col. 9, lins. 50 – 63; where a player is presented the option to attempt to double the award or keep the present award). Pierce does not disclose a recommendation that the player accepts an offer prior to revealing the offer to a player. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the basic and bonus game system including an option to keep a previous award offer or attempt a double or nothing game of Pierce with the method of withholding the first award offer before beginning a double or nothing round in order to either encourage a player to risk

more winnings for an additional game or encourage a player to prevent attempting greater winnings.

3. Claims 36 – 37, 39 – 40, 42 – 43 and 45 – 46 and 48 – 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of Walker et al. (U.S. Patent 6,001,016).

Regarding Claims 36 – 37, 39 – 40, 42 – 43 and 45 – 46 and 48 – 49, Pierce discloses a game system including a basic and bonus game, where basic and bonus games may be connected to each other via cable (col. 3, lins. 3 – 26), but does not disclose a data network or internet. However, Walker teaches a basic and bonus reel game system provided to the player through a data network, wherein the data network is an internet (col. 3, lins. 60 – 67), which allows a greater number of players to participate in a game. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the basic and bonus reel game system connected by generic cable of Pierce with the reel game system connected by Internet data network of Walker in order to increase the number of players that may play a game and provide a reliable wide area gaming environment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,010,404: Internet reel game.

U.S. Patent 6,190,255 B1: Bonus game choices.

U.S. Patent 6,494,785 B1: Bonus game choices, "Let's Make a Deal" style.

U.S. Patent 6,506,118 B1: Bonus game choices, "Let's Make a Deal" style.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aashish Karkhanis whose telephone number is (571) 272-2774. The examiner can normally be reached on 0800-1630 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ARK

CORBETT B. COBURN
PRIMARY EXAMINER